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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,082	06/27/2000	Steven M. Bessette	45112-089	4329

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EXAMINER

AFREMOVA, VERA

ART UNIT	PAPER NUMBER
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1657

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/604,082

Applicant(s)

BESSETTE ET AL.

Examiner

Vera Afremova

Art Unit

1657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4, 19, 45 and 50-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 19, 45 and 50-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/11/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 4, 19 and 45 as amended and new claims (10/11/2006) are pending and under examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 19 and 45 as amended and new claims 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07145598 and the IDS document "Pesticidal and Toxic Chemical News" from PROMT database (June 1994; database PROMT accession number 94:375291) taken with US 4,759,930 (Granirer et al.).

Claims are directed to a method for controlling household pests comprising step of contacting household pests with a pesticidal composition comprising a carrier and an active ingredient that is rosemary oil with peppermint oil or with phenethyl propionate or with both peppermint oil and phenethyl propionate. Some claims are further drawn to the specific household pests such as insects and arachnids including cockroaches and ants.

JP 07145598 discloses a method for controlling household pests comprising step of applying to a desired pest control location a pesticidal composition comprising 1) a pesticidally active ingredient with rosemary oil and peppermint oil and 2) a carrier in a form of additional plant oils (see English abstract; see official translation page 3/25 at section "purpose" and paragraphs 0020 and 0022). The method of the cited patent comprises identical active step of

Art Unit: 1657

contacting household pest by placing composition in a pocket or in a chamber (translation par. 0016) where pest control is desired. The cited patent teaches a disinfection effect of the composition (English abstract, for example) and, thus, the cited composition is reasonably expected to have pest-killing effects as intended for the claimed composition drawn to generic household pests. The household pests of the cited patent include mold and mites. The generic household pests of the instant application include mites as disclosed (page 4, line 28) and pests of foliage (page 4, line 25) that would include molds. Moreover, the generic arachnids encompassed by the claimed invention would include mites of the cited JP.

With respect to the newly added claims 50-55 as drawn to the specific household pests such as insects and arachnids including cockroaches and ants the cited US 4,759,930 (Granirer et al.) demonstrates that rosemary leaves and peppermint leaves provide for killing of insects, especially cockroaches (see examples 2, 4, 10, 12, 13, etc). The rosemary leaves and peppermint leaves are obviously contain essential oils at least in some amounts.

The cited JP 07145598 is lacking disclosure related to the use of phenethyl propionate in the compositions in the method for controlling or killing the household pests.

However, the cited document "Pesticidal and Toxic Chemical News" from PROMT database teaches that all presently claimed components including rosemary oil, peppermint oil and phenethyl propionate are pesticidally active ingredients.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to combine rosemary oil, peppermint oil and/or phenethyl propionate in any combination in pesticidal compositions with a reasonable expectation of success in extermination of pests including household pests as suggested by the prior art. One of

Art Unit: 1657

skill in the art would have been motivated to add phenethyl propionate to pesticidal composition of JP 07145598 in order to control and to kill the household pests for the expected benefits in maximizing pest extermination. It is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960). Thus, the claimed invention as a whole was clearly prima facie obvious, especially in the absence of evidence to the contrary.

The claimed subject matter fails to patentably distinguish over the state art as represented by the cited references. Therefore, the claims are properly rejected under 35 USC § 103.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1657

Claim 19 as amended and new claims 52 and 53 remain/are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,531,163 in view of US 4,759,930 as explained in the prior office action.

The claims in the present application and the patent US 6,531,163 are each drawn to a method for controlling household pests including cockroaches by applying to the locus where control is desired a pesticidally effective amount of a composition with peppermint oil and phenethyl propionate. The claims of US 6,531,163 are broader and the patented method is open to the use of additional materials including additional pesticidal materials. The claimed method of the present application is different from the patented claims in that it requires a rosemary oil for controlling pests. However, it is recognized in the art that the pest controlling effects including pest-killing effects are produced by applying the peppermint oil-containing composition together with the rosemary oil-containing composition as adequately demonstrated by US 4,759,930 (see examples 12, 13 and 15-21).

Accordingly, the claimed methods in the present application and the patent US 6,531,163 are obvious variants. Thus, the inventions as claimed are co-extensive.

Response to Arguments

Applicant's arguments filed 10/11/2006 have been fully considered but they are not all found persuasive.

1. Claim rejection under 35 U.S.C. 102(b) as being anticipated by JP 07145598 has been withdrawn in view of the applicant's argument that the cited method for killing house hold pests

Art Unit: 1657

encompasses the use of a combination of several essential components unlike to the claimed method that is limited to rosemary oil and peppermint oil as the sole active ingredients.

2. With regard to the claim rejection under 35 USC § 103 applicant appears to argue that the cited JP teaches the use of several essential components for controlling household pests unlike to the claimed method that is limited to rosemary oil and peppermint oil as the sole active ingredients and, therefore, one of skill in the art would not have been provided with a suggestion and/or motivation to select active ingredients in the claimed combination for killing household pests. This argument is not found particularly convincing with regard to the claim rejection under 35 USC § 103 because it is well known that it is prima facie obvious to combine ingredients that are taught by the prior art to be useful for the same purpose in order to form another composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually or in combinations for the same purpose in the prior art. In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960). Furthermore, when an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting of," applicant has the burden of arguing and/or showing that exclusion of additional steps and/or some "active" components would effect the basic novel and unobvious characteristics of the claimed invention. Thus, the claimed invention as a whole was clearly prima facie obvious, especially in the absence of evidence to the contrary.

3. With regard to the double patenting claim rejection applicants argue that claims of US 6,531,163 are devoid of any use of rosemary oil. Yet, the patented invention is open to

Art Unit: 1657

incorporation of additional active ingredients to the mixture of peppermint oil with phenethyl propionate and the cited patent clearly encompasses the use of additional essential oil. Rosemary derived essential oil is effective in method for combating household pests as adequately taught by the secondary reference. Thus, this claim rejection is proper. Applicants' intention to file Terminal Disclaimer is noted.

No claims are allowed in the instant office action.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1657

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Afremova whose telephone number is (571) 272-0914. The examiner can normally be reached from Monday to Friday from 9.30 am to 6.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon P. Weber, can be reached at (571) 272-0925.

The fax phone number for the TC 1600 where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology center 1600, telephone number is (571) 272-1600.

Vera Afremova

AU 1657

December 21, 2006



VERA AFREMOVA

PRIMARY EXAMINER